

REMARKS

Reconsideration is requested.

Claims 4, 5 and 7-27 are pending. Claims 10-14 and 16 have been withdrawn from consideration. Claims 1-3 and 6 have been canceled, without prejudice. Claim 27 has been added based on the paragraph bridging pages 2 and 3 of the specification which teaches that certain hydrophobic polymers themselves have satisfactory adhesives properties on the skin which can impart to a composition using them and excellent self-adhesiveness. If the polymer confers excellent self-adhesiveness to the compositions, one of ordinary skill in the art will appreciate that the presence of a tackifying resin would have no purpose and would therefore be omitted. Support for the amendments to claim 18 may be found at page 3, lines 18-21; original claim 3; page 3, lines 26-29; and page 4, lines 5-6 of the specification. No new matter has been added. Claims 4, 5, 7-9, 15 and 17-27 are under active consideration.

The specification has been amended to obviate the objection to the same by inserting a one-paragraph Abstract. Reconsideration and withdrawal of the objection to the specification are requested.

To the extent not obviated by the above amendments, the Section 112, first paragraph, rejection of claims 2-9, 15 and 17-26 stated on pages 2-3 of the Office Action dated January 27, 2003 (Paper No. 14) is traversed. Reconsideration and withdrawal of the rejection are requested in view of the above and the following comments.

Claim 18 has been amended to further recite specific ranges of the recited hydrophobic polymer and compound which are contained in the claimed solution. Claim

18 further recites specific copolymer units. The applicants believe in this regard that the claims, which recite copolymers derived from monomers selected from C₁-C₂₀ alkyl acrylates, as opposed to the ethylhexyl acrylate monomer believed to be enabled by the Examiner, and the vinyl acetate and acrylic acid monomers, acknowledged by the Examiner to be enabled by the specification, as well as the recited ranges, are supported by enabling disclosure. The applicants respectfully submit that the claimed definition of the self-adhesive polymer could be made and used by one of ordinary skill in the art, as claimed, without undue experimentation.

With respect to the recitation of specific fillers, believed to be required by the Examiner, the applicants submit that the use of fillers in the present art is well-known to one of ordinary skill in the art. Evidence of the same may be found in numerous issued patents by the U.S. Patent Office with claims which generally refer to "fillers" with less than exhaustive lists or exemplifications of specific fillers. The Examiner is requested to see, for example, in this regard U.S. Patent No. 4,994,264 (copy attached) which discloses in the specification at column 3, lines 60-61, only 4 types of fillers, i.e., talc, mica, TiO₂ coated mica and zinc oxide while reciting in claim 2 the general term "fillers". The Examiner is also requested to see the attached U.S. Patent No. 5,750,120, which discloses in the specification at column 1, lines 48-57, 4 types of fillers and which nevertheless recites in the main claim the general term "fillers". Further examples of general recitations of fillers and less than complete definitions of the same in the specification of U.S. Patents are described in the attached Appendix I. Copies of the noted patents are attached. The Examiner is urged therefore in view of the above and attached, to appreciate that the art with regard to fillers is quite advanced and the

claimed invention could be made and used by one of ordinary skill in the art without undue experimentation.

As noted above, the applicants respectfully and specifically request an interview with the Examiner and the Examiner's supervisor to discuss, in particular, this aspect of the claimed invention in the event the Examiner continues to reject the claims for failure to be supported by an enabling disclosure.

Withdrawal of the Section 112, first paragraph, rejection of claims 2-9, 15 and 17-26 is requested.

The Section 112, second paragraph, rejection of claims 2-9, 15 and 17-26 is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following comments.

The applicants respectfully submit again that claim 18 excludes the presence of water in a substantial amount. This would be recognized by one of ordinary skill in the art as the claim recites the composition is in the form of a solution and that the copolymer is a hydrophobic polymer. One of ordinary skill in the art would appreciate that the recited hydrophobic polymer is insoluble in water. The presence of a substantial amount of water and 20 to 60% of a hydrophobic polymer, as required by claim 18, would not form a solution, as claimed. Accordingly, the transition phrase "consisting essentially of" with the recitations of the requirement for a "solution" and the presence of 20-60% of the hydrophobic polymer, as claimed, will all be recognized by one of ordinary skill in the art to exclude the presence of water in a substantial amount. That is, one of ordinary skill in the art would appreciate that the presence of the substantial amount of water would change the nature of the composition and, to the

extent the applicants bear any burden to show such a substantial change, the applicants believe the burden has been met.

Withdrawal of the Section 112, second paragraph, rejection of claims 2-9, 15 and 17-26 is requested.

The Section 103 rejection of claims 2-9, 15, 17-22, 25 and 25 over Higo (WO 96/16642, as interpreted by U.S. Patent No. 5,866,157) is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following distinguishing comments.

Contrary to the Examiner's assertion, the presence of the tackifying resin is implicitly excluded in the claimed compositions as such a resin would clearly be contrary to the teachings of the specification. In fact, the specification explicitly states that the invention is based on the discovery that certain hydrophobic polymers have, by themselves, satisfactory adhesive properties on the skin and that the use of a solution of these polymers makes it possible to obtain, after evaporation of the solvent media, devices which have excellent self-adhesiveness (see, pages 2-3 of the specification). The claimed composition, which is free of the substantial quantity of tackifying resin, is clearly not suggested by Higo who teaches at column 4, lines 32-35 of the U.S. Patent that if the amount of tackifying resin is less than 10% (w/w), a sufficient adhesive force and patch formulation cannot be obtained. Accordingly, Higo is believed to be contrary to the presently claimed invention.

Withdrawal of the Section 103¹ rejection is requested.

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The claims are submitted to be in condition for allowance and a Notice that effect is requested. The applicants again request an interview with the Examiner in the event any further issues remain.

The Examiner is requested to contact the undersigned to arrange an interview at a time convenient for the Examiner and the Examiner's supervisor.

Respectfully submitted,

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By: _____



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